

present application has been amended so as to include the application serial number for each of the related applications appearing on page 2 of the specification. Following amendment by this paper, claims 1-30 are submitted to the Examiner for further consideration.

In the Office Action dated August 29, 2000 (Paper No. 4), the Examiner indicated that the present application contains claims directed to the following patentably distinct species of the claimed invention: skin care product, hair care product, and toothpaste. In this regard, the Examiner required election of one of these three species, indicating that claim 1 is generic.

In response, applicant elects without traverse the skin care product species. In this regard, applicant believes that each of claims 1-5, 13-22, and 27-28 is generic, and that each of claims 6-9 and 23 is readable upon the skin care product species elected. Hence, it is respectfully submitted that claims 1-9, 13-23, and 27-28 fall within the scope of the election as exercised.

In the Office Action, claim 1 was rejected under 35 U.S.C. § 102(b) as being anticipated by Van Wessem et al. (U.S. Patent No. 3,227,616). Claims 1-28 were rejected under 35 U.S.C. § 103(a) over Van Wessem et al., Kashibuchi et al. (U.S. Patent No. 5,565,207), Meybeck et al. (U.S. Patent No. 5,663,160), and Emerson et al. (U.S. Patent No. 5,676,958).

With regard to the Van Wessem et al. patent, the Examiner alleges that Van Wessem et al. disclose the use of various saccharides as a component of cosmetic preparations. In this regard, the Examiner alleges that claims 1 and 2, column 1, lines 26-59, and Examples I-IV

of Van Wessem et al. disclose the invention of applicant's claim 1. Such is clearly not the case.

The title of the Van Wessem et al. patent is "Emulsions of Cactus Plant Extract". It is respectfully submitted that those skilled in the art would understand the term "cactus plant" to mean the plant itself, namely, the pads and stems, not the fruit of the cactus plant. In this regard, both claims 1 and 2 of Van Wessem et al. cited by the Examiner expressly state that it is the *Opuntia vulgaris* plant extract or cactus plant extract which is employed in the cosmetic preparations of Van Wessem et al. By stark contrast, there is not even one reference in the entire Van Wessem et al. patent to the term "fruit", as it relates to cactus or otherwise. Clearly, a fair reading of the Van Wessem et al. patent by those skilled in the art would be that the cactus plant extract employed is from the cactus plant itself, namely, the pads and stems, not the cactus fruit. The glaring omission of the term "fruit" in the Van Wessem et al. patent punctuates this point.

Further evidence that the cactus fruit was not intended for use in the cosmetic preparations of Van Wessem et al. is found in the Van Wessem et al. patent itself. In this regard, at column 2, line 11, the cactus plant extract set forth in Example I of Van Wessem et al., which was referenced by the Examiner in the Office Action, is referred to as the "vegetable matter". Again, those of ordinary skill in the art would understand that the term "vegetable matter" relates to the cactus plant itself, namely, the pads and stems, and not to the fruit. As further evidence of such understanding, applicant has enclosed a reference from the website desertusa.com, a copy of which is enclosed.

In the enclosed desertusa.com reference, a discussion regarding “nopales” appears. In this regard, the article states that “nopales” is the Spanish name for prickly pear cactus pads. The article further states that prickly pear cactus are members of the Opuntia genus, and produce both nopales which is a vegetable, and tuna, which is a fruit. Thus, it is clear that Van Wessem et al.’s. usage of the term “vegetable” to describe the cactus plant employed in the cosmetic preparations of Van Wessem et al. has reference to the nopales portion of the cactus plant, i.e., the pads. Clearly, the Examiner has failed to produce any prior art reference showing the usage of cactus fruit in a skin care product, topical skin application, body treatment composition, or dental care product as disclosed and claimed by applicant.

Other references are enclosed herewith to further evidence that the term “cactus plant” as used by Van Wessem et al. means the pads or stems of the cactus plant, not the fruit thereof. For the Examiner’s reference, copies of the references referenced herein are enclosed for the Examiner’s thorough review and consideration. A brief discussion of those references follows.

At the website arizonacactus.com, there is a discussion regarding the use of the prickly pear cactus (Opuntia) by the Indian tribes living in the desert climates of northern Mexico and the southwestern United States. In this reference, it is made clear that it is the pads of the prickly pear cactus which are used by such Indian tribes for application to the skin for various medical purposes. For example, it is stated that a prickly pear cactus pad may be applied to the body to relieve rheumatic and asthmatic symptoms, to treat earaches, to relieve hemorrhoids, and to treat minor rashes, sunburn, and wind burn.

Further enclosed is a reference from the website pagansonline.com, reporting experiments to find out the extent of the hypoglycemic effect of crude extracts of Opuntia on patients with type II diabetes mellitus. Note that in this medical study, Opuntia stems were ingested. The study indicates that the oral intake of broiled Opuntia stems caused a significant decrease of serum glucose level. (Although this medical application of Opuntia stems involved oral intake of the same, rather than application to the skin, it is cited to show that Opuntia stems have been again employed for medical purposes, rather than looking to the fruit for such purposes.)

The cited references thus evidence the use of prickly pear cactus pads for medical purposes, but do not mention the use of prickly pear cactus fruit for medical purposes or, more importantly, for application to the skin for any purpose. The Examiner has cited absolutely no evidence that the prickly pear cactus fruit has been ever been used for application to the skin for any purpose whatsoever.

The use of ginseng berry extract in certain preferred embodiments of applicant's invention will now be addressed. In rejecting each of claims 1-28 in paragraph 4 of the Office Action, the Examiner expressly acknowledged that Van Wessem et al. do not include "ginseng" in their formulation. The Examiner thus relies on Kashibuchi et al., Meybeck et al., and Emerson et al. to show the use of "ginseng" in a skin care product, topical skin application, body treatment composition, or dental care product as disclosed and claimed by applicant.

First, it is important to note that the Examiner has apparently overlooked the fact that the essence of applicant's invention involving "ginseng" as set forth, for example, in claims

5, 13, 26, and 28, involves the use of the ginseng berry, not the ginseng root or plant. In this regard, as evidenced at page 9, lines 12-17 of the present application, specific embodiments of the present invention are directed towards a skin care product, topical skin application, body treatment composition, or dental care product, containing extract from the ginseng berry. As evidenced by this passage, although the ginseng root has sometimes been used as an herbal supplement, the ginseng berry has been overlooked for human use, which is believed to be due, at least in part, to the high seed content of the ginseng berry. In this regard, ginseng berries contain a large number of seeds which make up a large percentage of the berries' volume. These seeds must be painstakingly removed by applicant in order to make suitable skin care products in accordance with the present invention. Claims 5, 13, 26, and 28 of the present application thus set forth various skin care products comprising "ginseng berry extract".

As evidenced, for example, at page 9, line 18 through page 10, line 10 of applicant's specification, the ginseng berry contains a high concentration of essential vitamins, and advantageously, ginseng berry extract also acts as an anti-oxidant. Applicant has discovered that ginseng berry extract provides beneficial effects when applied to the skin in accordance with the teachings of the present invention. Importantly, these benefits are achieved through the use of an extract from the ginseng berry in the skin care products, topical skin applications, body treatment compositions, and dental care products of the present invention, rather than from the ginseng root which is used in the prior art as a nutritional supplement. Certainly, ginseng root extracts can be added to the novel skin care products, topical skin applications, body treatment compositions, and dental care products of the present invention

as seen, for example, in dependent claim 22, but the primary skin care products, topical skin applications, body treatment compositions, and dental care products of the present invention are based upon the extract of the ginseng berry. In fact, the references relied upon by the Examiner in the outstanding Office Action evidence that, although it has been known that the ginseng root may be used in various nutritional supplements, the ginseng berry has been overlooked, and is certainly not used in skin care products such as disclosed and claimed by applicant.

In the Office Action, the Examiner rejected each of claims 1-28 relying upon Kashibuchi et al., Meybeck et al., and Emerson et al. as showing the use of “ginseng”. It is respectfully submitted that a fair reading of each of these references by those skilled in the art would result in the conclusion that the “ginseng” being referred to is in fact the ginseng root, not the berry.

The Kashibuchi et al. patent discloses a scalp moisturizer and external skin preparation including a steroid glycoside and/or triterpenoid glycoside, a sphingo glycolipid, and a steroid hormone. It is noteworthy that there were found only two passing references to “ginseng” in the entire Kashibuchi et al. patent. First, at column 5, line 61-67 of Kashibuchi et al., a number of additional ingredients which might be included are listed; “organic solvent extracts of ginseng” are included in the extensive list. Second, in Table 4 at column 12, line 48 of Kashibuchi et al., “ginseng extract” is listed as comprising 0.1% of the formulation of Kashibuchi et al.’s Example No. 6. Remarkably, the term “ginseng” is completely absent from the Kashibuchi et al. claims. Even more noteworthy is the fact that the ginseng berry is mentioned nowhere in Kashibuchi et al. It is respectfully submitted that,

(and as will be supported by the additional evidence presented hereinafter), those skilled in the art would understand that the “ginseng extract” referred to in Kashibuchi et al. refers to an extract from the ginseng root, not the berry.

The Meybeck et al. patent discloses cosmetic or dermatological compositions for treating hair, allegedly for promoting hair growth. In the Meybeck et al. patent, reference is made, for example, to “ginseng”, “*Panax notoginseng*”, “*Panax ginseng*”, and “white ginseng”. Importantly, however, the Meybeck et al. patent makes it clear that it is the root of the ginseng that is used, not the berry. In this regard, absolutely no reference is made in Meybeck et al. to the ginseng berry. On the other hand, the Meybeck et al. patent refers repeatedly to the root when referring to ginseng. See, for example, the Meybeck et al. patent at column 3, lines 5-6; column 4, lines 35-37; column 5, lines 63-65; and column 7, lines 42-43. In this regard, in explaining exactly what is meant by “white ginseng”, at column 7, lines 42-43, Meybeck et al. state: “White ginseng is a root of *Panax ginseng*, which is simply peeled and dried.” [Underlined emphasis added.] Unmistakably, Meybeck et al. employ the ginseng root in their formulations.

The Emerson et al. patent discloses insecticide formulations including aromatic aldehydes having a formula as set forth, for example, in formula 1 at column 4, lines 10-22 of Emerson et al. In the passage cited by the Examiner at column 6, line 47 through column 7, line 64 of Meybeck et al., additional components which may be added to the insecticide formulation are set forth. Saponins are given as examples of such additional components which may be added. An extensive list of various saponin sources is set forth at column 7, lines 53-64 and includes “ginseng”. This is the sole reference to “ginseng” in the entire

Emerson et al. patent. Again, “ginseng” is mentioned nowhere in the claims, and there is certainly no mention whatsoever of the ginseng berry.

In describing the various plant parts which may be employed with respect to the extensive list of saponin sources set forth at column 7, lines 53-64 of Emerson et al., the “root” is listed at column 7, line 55. Emerson et al. made no attempt to indicate which specific plant parts are used for which of the specific saponin sources listed. It is respectfully submitted, however, that those skilled in the art, upon seeing the term “ginseng” at column 7, line 58, and upon seeing the term “root” at column 7, line 55 of Emerson et al., would understand that it is the ginseng root that is being used by Emerson et al. In this regard, even though the term “fruit” also appears at column 7, line 55 of Emerson et al., those skilled in the art would know that such term applies to other of the listed saponin sources as they know and understand that in the ginseng world, reference to “ginseng” traditionally means the root thereof, not the fruit or berry.

Evidence that the term “ginseng” alone refers to the root, and not the berry, can be found in a standard dictionary. Enclosed for the Examiner’s reference is a copy of the definition of “ginseng” from Webster’s Unabridged Dictionary. As noted in the enclosed dictionary definition, “ginseng” has two meanings: (1) an herb with a thick, forked, aromatic root, and (2) the root of this plant used medicinally by the Chinese. Notably, as seen, the first meaning of the term “ginseng” in referring to the herb itself, expressly defines the herb in terms of its distinctive aromatic root. The second meaning of the term “ginseng” is in fact the root itself. Thus, it is clear that if one refers simply to “ginseng” alone, it must either be to the herb having an aromatic root or to the root itself. In other words, reference to



“ginseng” alone would not typically mean the berry unless one referred specifically to the “ginseng berry”.

To provide further evidence that the term “ginseng” as used in the cited references relied upon by the Examiner refers to the ginseng root and not the berry, some research was conducted over the regarding the normal and traditional usage of the term “ginseng”. For the Examiner’s reference, copies of the references discovered during the search are enclosed for the Examiner’s careful review and consideration. A brief discussion of those references follows.

At the Health Central website (located at the URL noted in the enclosure), an Herb Library is found which contains a detailed description of ginseng. As seen on page 2 of that enclosed reference, in referring to ginseng, it is stated that: “Regardless of species, the part of the plant used is the root.” Repeated reference is made throughout this reference to the root of the ginseng, with not one single reference to the berry.

At the website mothenature.com, a description of Asian ginseng is given. There, under the heading “Parts used and where grown” it is made clear that “The root is used.” The ginseng “berry” is nowhere mentioned.

At the website healthy.net, an herbal encyclopedia describing ginseng is found. Again, this reference states: “Part Used: Root”. The ginseng “berry” is nowhere mentioned.

At the website botanical.com, another herbal encyclopedia is found describing ginseng. Again, repeated reference is made to the “root”, and the reference expressly indicates: “Part Used - - - Root”. The ginseng “berry” is nowhere mentioned.

At the website kcweb.com, an “Herbal Information Center” is found describing ginseng. Again, repeated reference is made to the “root”, and the reference expressly states: “Part Used: Whole Root”. The ginseng “berry” is nowhere mentioned.

There are many other references discovered in the search describing ginseng, which make repeated reference to the “root”, with not one single reference to the berry. In this regard, references from herb.com, the HealthLink Online website (located at the URL noted in the enclosure), quickchange.com, oxford.net, ginsengcompany.com, witchs-brew.com, herbphoto.com, and naturalland.com are enclosed for the Examiner’s careful review and consideration.

In view of the overwhelming evidence that those skilled in the art traditionally consider the term “ginseng” to refer to the root, not the berry, it is respectfully submitted that unless the Examiner has some credible evidence or rational reason to contradict the many references found in the research conducted and to contradict the traditional meaning of the term “ginseng” used over the years to refer to the root thereof, the Examiner cannot on the Examiner’s own initiative adopt a new meaning of the term “ginseng” to mean the fruit or berry thereof, and the Examiner must accept the established and traditional meaning. Absent such evidence from the Examiner, it is clear that the only fair reading of the Kashibuchi et al., Meybeck et al., and Emerson et al. patents is to conclude that the reference to “ginseng” found in those patents is to the root of the ginseng. Accordingly, it is respectfully submitted that the claims are further distinguishable over the cited art of record where “ginseng berry extract” is claimed in connection with a skin care product, topical skin application, body treatment composition, or dental care product of the present invention.

Moreover, it is respectfully submitted that the combinations defined by the various other dependent claims are also novel and nonobvious, and are thus independently patentable. In this regard, it is respectfully submitted that the combinations of features set forth in the various other dependent claims are neither disclosed in the art of record nor rendered obvious thereby.

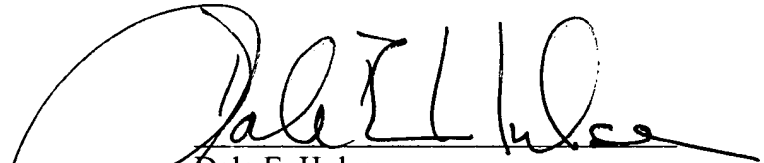
In the Office Action, the Examiner acknowledged receipt of applicant's Information Disclosure Statement dated December 7, 1999 and Supplemental Information Disclosure Statement dated December 22, 1999. Further, at box 17 of the Office Action, the Examiner indicated that initialled Forms PTO-1449 were being returned for both of these Statements (Paper Nos. 2 and 3). However, only an initialled copy of the Form PTO-1449 accompanying applicant's Information Disclosure Statement dated December 7, 1999 was actually received with the Office Action. Inadvertently, the initialled Form PTO-1449 relating to applicant's Supplemental Information Disclosure Statement dated December 22, 1999 was not returned with the Office Action as indicated. Accordingly, it is respectfully requested that the Examiner return an initialled copy of the Form PTO-1449 relating to the Supplemental Information Disclosure Statement dated December 22, 1999 with the next communication.

In addition, on October 16, 2000, a further Supplemental Information Disclosure Statement was submitted by applicant. It is respectfully requested that the Examiner also initial and return the Form PTO-1449 which accompanied applicant's Supplemental Information Disclosure Statement dated October 16, 2000 with the next communication.

In view of the foregoing, it is respectfully submitted that each of claims 1-30 is in condition for immediate allowance, and such action is courteously requested. In the event the Examiner finds any remaining impediment to the prompt allowance of any of these claims which could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate the same with the undersigned.

DATED this 17<sup>th</sup> day of November, 2000.

Respectfully submitted,

A large, stylized handwritten signature in black ink, appearing to read 'Dale E. Hulse'.

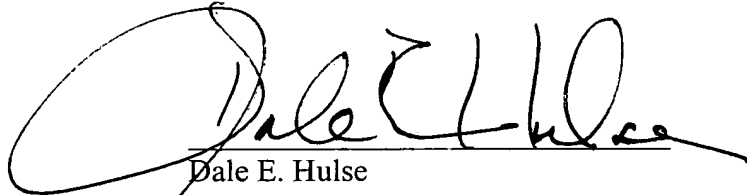
Dale E. Hulse  
Attorney for Applicant  
Registration No. 29,654

KIRTON & McCONKIE  
1800 Eagle Gate Tower  
60 East South Temple  
Salt Lake City, Utah 84111  
Telephone: (801) 328-3600



CERTIFICATE OF DEPOSIT UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D. C. 20231, on this 17<sup>th</sup> day of November, 2000.



Dale E. Hulse  
Attorney for Applicant  
Registration No. 29,654

KIRTON & McCONKIE  
1800 Eagle Gate Tower  
60 East South Temple  
Salt Lake City, Utah 84111  
Telephone: (801) 328-3600

Transmitted:  
Amendment  
Cited references

W:\7500\7537\0029\dehAmendmentFRM.wpd